Attorney's Docket No.: 042390.P9468   Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: Andrew J. Fish	Examiner: Truong, Lechi
Application No. 09/737,140	Art Unit: 2126
Filed: December 13, 2000	
For: Extensible Bios Error Log	**FIRST CLASS CERTIFICATE OF MAILING**

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

APPEAL BRIEF UNDER 37 C.F.R. §1.192

Sir:

The Applicant hereby submits this Brief in support of its appeal from a

final decision of the Examiner in the above-captioned case.

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(1) REAL PARTY IN INTEREST

Intel Corporation of Santa Clara, CA.

(2) RELATED APPEALS AND INTERFERENCES

No related applications.

(3) STATUS OF CLAIMS

In this application, Claims 1 - 27 are pending.

Examiner rejected claims 1, 2, 5, 6, 10, 11, 14, 15, 19, 20, 23, and 24 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,732,282 (hereinafter "Provino") in view of Admitted Prior Art (APA.)

Applicant appeals the Examiner's decision on Claims 1, 2, 5, 6, 10, 11, 14, 15, 19, 20, 23, and 24 with respect to the rejection under Sections 103.

(4) STATUS OF AMENDMENTS

A final office action was mailed May 4, 2004 rejecting claims 1, 2, 5, 6, 10, 11, 14, 15, 19, 20, 23, and 24 for the reasons specified above. A response after final was filed August 4, 2004.

The claims found in the Appendix of this Appeal Brief reflect the claims as they are understood by the Applicant to stand at the date of this appeal.

(5) SUMMARY OF INVENTION

According to one aspect of the invention, a method includes a processor executing a BIOS routine receiving information from at least one first computing system units; the processor storing the received information in a memory; and for each second computing system units, the processor receiving an initial request for the received information from the second computing system unit, in response to the request the processor providing to the second computing system units at least one of the received information stored in the memory before a receipt of the request, and the processor providing to the second computing system unit at least one of the received information received subsequent to the request. (See **Figure 2.**)

6) <u>ISSUES</u>

In the Final Office Action mailed May 4, 2004, the Examiner has:

(1)   continued a rejection of claims 1, 2, 5, 6, 10, 11, 14, 15, 19, 20, 23,

and 24 under 35 U.S.C. § 103(a) as being unpatentable over U.S.

Provino in view of APA.

The question presented on this Appeal is:

(1)   Whether the statements made by applicant in the "background"

section of the pending application are in fact admissions of prior

art?

(7) <u>GROUPING OF CLAIMS</u>

Claims 1 - 27 are grouped together.

(8) <u>ARGUMENT</u>

Question 1 -- Whether Statements Made By Applicant In The Application Are To

Be Considered Prior Art?

<u>PROBLEMS INVOLVED IN THE PRIOR ART SHOULD BE INDICATED AND
ARE NOT TO BE CONSIDERED ADMISSIONS OF PRIOR ART (MPEP,
section 608.01(c)).</u>

As stated above the examiner rejected claims independent claim 1, 10, and

19 under 35 U.S.C. § 103(a) as being unpatentable over Provino in view of

applicant's alleged APA.

The examiner states that applicant has made certain admissions of prior art in the background section of applicant's application. In particular, the examiner states applicant has made the admission that component and system information obtained by a first device **is** shared with another device, and is therefore an admission of prior art. In support of the examiner's position, the examiner makes reference to the following statement in applicant's background:

> During a computer system BIOS routine initialization, each device sequentially initializes under the control of the executing BIOS routine. <u>However, at least one device that has already initialized may acquire component and system information that is useful to</u> **and should be provided to at least one other device**. Examples of such information is a device that has tried to read from a memory (e.g., a disk) and encountered an error, and a device that is coupled to a channel that is presumed to be losing data. This information includes error information , status information, configuration information, and event information pertaining to devices and systems. <u>The acquired information</u> **should be able to be made available to other devices**. These other devices can include information logging devices and devices whose execution and/or state may be dependent upon the information. (emphasis added.) (Applicant's application, pg. 3, lines 9-19.)

Applicant respectfully disagrees with the examiner. Certain statements included in the background are identifications of problems in the prior art and/or problems that are solved by applicant's invention. The statements are clearly not an admission of prior art.

Simply because the statements have been provided in the background section of the application does not make the statements admissions of prior art. Rather, as stated in the MPEP, in the Background section, "where applicable, the

problems involved in the prior art or other information disclosed which are solved by the applicant's invention should be indicated." (MPEP, section 608.01(c)).

In the case at hand, consider the following statement from above:

> During a computer system BIOS routine initialization, each device sequentially initializes under the control of the executing BIOS routine. <u>However, at least one device that has already initialized may acquire component and system information that is useful to</u> **and should be provided to at least one other device**. . . .
>
> <u>The acquired information</u> **should be able to be made available to other devices**.
> (emphasis added.) (Applicant's application, pg. 3, lines 9-17.)

Clearly applicant is identifying a shortcoming in the prior art by stating that component and system information obtained by a device **should be shared with at least one other device.** Applicant is clearly stating component and system information obtained by a device not currently shared, but there is a need to share the information with other devices.

Therefore, applicant respectfully submits that applicant's statement that component and system information obtained by one device and should be shared and made available to other devices, is not an admission of prior art.

Furthermore, considering Provino does not disclose all of applicant's claimed limitations, applicant's claims are patentable over Provino.

CONCLUSION

For all of the foregoing reasons, this Board is respectfully requested to remand this application to the Examiner for reconsideration consistent with an order that the Examiner pass this case to issuance unless a proper rejection to the claims can be made.
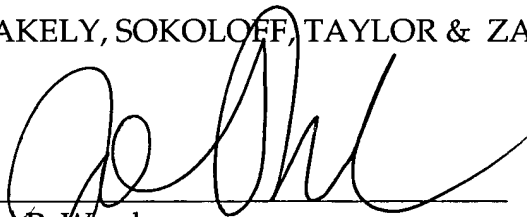
FEE FOR FILING A BRIEF IN SUPPORT OF APPEAL

Enclosed is a check in the amount of $340.00 to cover the fee for filing of a brief in support of an appeal required under 37 C.F.R. 1.17(f) and 1.192.

CHARGE OUR DEPOSIT ACCOUNT

Please charge any shortage to our Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: 10/04/2004

John P. Ward
Attorney for Applicant
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Appendix A

1.   (Previously Presented) A method comprising:

a processor executing a BIOS routine by receiving information from at least one first computing system units, the information comprises at least one of error information, status information, and configuration information;

the processor executing the BIOS routine by storing said received information in a memory;

for each of at least one second computing system units,

the processor executing the BIOS routine by receiving an initial request for said received information from the second computing system unit;

the processor executing the BIOS routine by providing to the second computing system unit in response to said received request at least one of said received information stored in said memory before the receipt of said request if any is stored; and

the processor executing the BIOS routine by providing to the second computing system unit at least one of said received information received subsequent to said request.

2.   (Original) The method defined in claim 1 wherein said information comprises at least one of unit information, system information, error information, status information, configuration information, and event information.

3.   (Original) The method defined in claim 1 wherein the receiving said information from the first units is according to an API.

4. (Original) The method defined in claim 1 wherein the providing said information to the second units is according to an API.

5. (Original) The method defined in claim 1 wherein the storing the received information in a memory is according to a time of receipt of said information.

6. (Original) The method defined in claim 1 wherein the providing the received information stored in the memory before a receipt of said request is according to a time of receipt by said processor.

7. (Original) The method defined in claim 1 wherein said information received by said processor is appended to include at least one of a sequence number and an absolute time.

8. (Original) The method defined in claim 1 wherein the provided received information stored before the receipt of said request includes one of all said received information and a categorized subset of all said received information.

9. (Original) The method defined in claim 1 wherein the provided information received subsequent to said request includes one of all said received information and a categorized subset of all said received information

10. (Previously Presented) A machine-readable medium that provides instructions, which when executed by a processor, cause said processor to perform operations comprising:

during execution of a BIOS routine, receiving information from at least one first computing system units, the information comprises at least one of error information, status information, and configuration information;

during execution of the BIOS routine, storing said received information in a memory;

for each of at least one second computing system units,

during execution of the BIOS routine, receiving an initial request for said received information from the second computing system unit;

during execution of the BIOS routine in response to said request, providing to the second computing system unit at least one of said information stored in said memory before the receipt of said request if any is stored; and

during execution of the BIOS routine, providing to said second computing system unit at least one of said received information received subsequent to said request.

11.   (Original) The medium defined in claim 10 wherein said information comprises at least one of unit information, system information, error information, status information, configuration information, and event information.

12.   (Original) The medium defined in claim 10 wherein the receiving information is according to an API.

13.   (Original) The medium defined in claim 10 wherein the providing said information stored to the second units is according to an API.

14. (Original) The medium defined in claim 10 wherein the storing the received information in a memory is according to a time of receipt of said information.

15. (Original) The medium defined in claim 10 wherein the providing the received information stored in the memory before a receipt of said request is according to a time of receipt by said processor.

16. (Original) The medium defined in claim 10 wherein the information received is appended to include at least one of a sequence number and an absolute time.

17. (Original) The medium defined in claim 10 wherein the provided information stored before the receipt of said request includes one of all said received information and a categorized subset of all said received information

18. (Original) The medium defined in claim 10 wherein the provided information received subsequent to said request includes one of all said received information and a categorized subset of all said received information

19. (Previously Presented) A computer that comprises:
a stored BIOS program in a non-volatile memory that includes instructions that cause said computer to:

  receive information from at least one first units coupled to said computer, the information comprises at least one of error information, status information, and configuration information;

  store said received information in a memory;

for each of at least one second units coupled to said computer,

receive an initial request for said information from the second unit;

in response to said request, provide to the second unit at least one

of said information stored in said memory before the receipt of said

request if any is stored, and

provide to the second unit at least one of said received information

to the second unit received subsequent to said request.

20. (Original) The computer defined in claim 19 where the information includes at least one of unit information, system information, error information, status information, configuration information, and event information.

21. (Original) The computer defined in claim 19 wherein the receive information from the first units is according to an API.

22 (Original) The computer defined in claim 19 wherein the provide to the second unit information is according to an API.
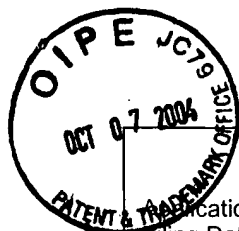

23. (Original) The computer defined in claim 19 wherein the store the received information in a memory is according to a time or receipt of said information.

24. (Original) The computer defined in claim 19 wherein the provide the received information stored in the memory before a receipt of said request is according to a time of receipt of said information.

25.   (Original) The computer defined in claim 19 wherein the information received by said processor is appended to include at least one of a sequence number and an absolute time.

26.   (Original) The computer defined in claim 19 wherein the provided information stored before the receipt of said request includes one of all said received information and a categorized subset of all said received information.

27.   (Original) The computer defined in claim 19 wherein the provided information received subsequent to said request includes one of all said received information and a categorized subset of all said received information.

AMENDMENT TRANSMITTAL

PATENT

Application No.: ___09/737,140___
Filing Date: ___December 13, 2000___
First Named Inventor ___Andrew J. Fish___
Examiner's Name: ___Truong, Lechi___
Art Unit: ___2126___
Attorney Docket No.: ___042390.P9468___

_____	An Amendment After Final Action (37 CFR 1.116) is attached and applicant(s) request expedited action.
__X__	Charge any fee not covered by any check submitted to Deposit Account No. 02-2666.
__X__	Applicant(s) hereby request and authorize the U.S. Patent and Trademark Office to (1) treat any concurrent or future reply that requires a petition for extension of time as incorporating a petition for extension of time for the appropriate length of time and (2) charge all required fees, including extension of time fees and fees under 37 CFR 1.16 and 1.17, for any concurrent or future reply to Deposit Account No. 02-2666.
_____	Applicant(s) claim small entity status (37 CFR 1.27).

ATTACHMENTS

_____	Preliminary Amendment
_____	Amendment/Response with respect to Office Action
_____	Amendment/Response After Final Action (37 CFR 1.116) (reminder: consider filing a Notice of Appeal)
__X__	Appeal Brief plus two copies
_____	RCE (Request for Continued Examination)
_____	Supplemental Declaration
_____	Terminal Disclaimer (reminder: if executed by an attorney, the attorney must be properly of record)
_____	Information Disclosure Statement (IDS)
_____	Copies of IDS citations
_____	Petition for Extension of Time
__X__	Fee Transmittal Document (that includes a fee calculation based on the type and number of claims)
_____	Cross-Reference to Related Application(s)
_____	Certified Copy of Priority Document
_____	Other: _____
_____	Other: _____
__X__	Check
__X__	Postcard (Return Receipt)

SUBMITTED BY:

BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP

TYPED OR PRINTED NAME: ___John P. Ward___

SIGNATURE: _____

REG. NO.: ___40,216___

DATE: ___October 4, 2004___

ADDRESS: 12400 Wilshire Boulevard, Seventh Floor

Los Angeles, California 90025

TELEPHONE NO.: (408) 720-8300

CERTIFICATE OF MAILING BY FIRST CLASS MAIL (if applicable)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage in an envelope addressed to Mail Stop Appeal Brief – Patents, Commissioner for Patents, P.O. Box 1450, Alexandria Virginia 22313-1450 on ___10/04/2004___

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Judy L. Steinkraus ___ Name of Person Mailing Correspondence ___ 10/04/2004

Signature ___ Date

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3. ADDITIONAL FEES

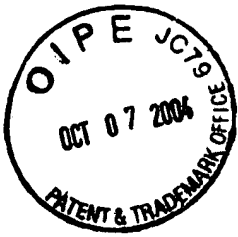| Large Entity		Small Entity			
Fee Code	Fee ($)	Fee Code	Fee ($)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late filing fee or oath	_____
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	_____
1053	130	1053	130	Non-English specification	_____
1812	2,520	1812	2,520	For filing a request for ex parte reexamination	_____
1813	8,800	1813	8,800	Request for inter parties reexamination	_____
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	_____
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	_____
1251	110	2251	55	Extension for reply within first month	_____
1252	430	2252	215	Extension for reply within second month	_____
1253	980	2253	490	Extension for reply within third month	_____
1254	1,530	2254	765	Extension for reply within fourth month	_____
1255	2,080	2255	1,040	Extension for reply within fifth month	_____
1401	340	2401	170	Notice of Appeal	_____
1402	340	2402	170	Filing a brief in support of an appeal	340.00
1403	300	2403	150	Request for oral hearing	_____
1451	1,510	1451	1,510	Petition to institute a public use proceeding	_____
1452	110	2452	55	Petition to revive – unavoidable	_____
1453	1,370	2453	685	Petition to revive - unintentional	_____
1501	1,370	2501	685	Utility issue fee (or reissue)	_____
1502	490	2502	245	Design issue fee	_____
1503	660	2503	330	Plant issue fee	_____
1460	130	1460	130	Petitions to the Commissioner	_____
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	_____
1806	180	1806	180	Submission of Information Disclosure Stmt	_____
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	_____
1809	790	2809	395	For filing a submission after final rejection (see 37 CFR 1.129(a))	_____
1814	110	2814	55	Statutory Disclaimer	_____
1810	790	2810	395	For each additional invention to be examined (see 37 CFR 1.129(b))	_____
1801	790	2801	395	Request for Continued Examination (RCE)	_____
1802	900	1802	900	Request for expedited examination of a design application	_____
1504	300	1504	300	Publication fee for early, voluntary, or normal pub.	_____
1505	300	1505	300	Publication fee for republication	_____
1803	130	1803	130	Request for voluntary publication or republication	_____
1808	130	1808	130	Processing fee under 37 CFR 1.17(i) (except provisionals)	_____
1454	1,370	1454	1,370	Acceptance of unintentionally delayed claim for priority	_____

Other fee (specify) _____ _____

Other fee (specify) _____ _____

SUBTOTAL (3) $ 340.00

*Reduced by Basic Filing Fee Paid

SUBMITTED BY:

Typed or Printed Name: John P. Ward

Signature: _____ Date: October 4, 2004

Reg. Number: 40,216 Telephone Number: 408-720-8300

Send to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

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_____ *Judy L. Steinkraus*   10/04/2004

Judy L. Steinkraus

P9468

Application No.: 09/737,140	**Filing Date:** December 13, 2000
Date Mailed: 10/04/2004	**Due Date:** 10/04/2004

Docket No.: 42390.P94

Atty/Sec: JPW/pmr

Client: Intel Corporation
Title: Extensible Bios Error Log
First Named Inventor: Andrew J. Fish

The following has been received in the U.S.P.T.O. on the date stamped hereon:

Transmittal Letters & Certificate of Mailing
- ☒ Transmittal Letter
- ☒ Fee Transmittal (original & copy)
- ☐ RCE (Request for Continued Examination)
- ☐ Transmittal of Formal Drawings
- ☐ Issue Fee Transmittal (original & copy)
- ☒ Certificate of Mailing
- ☐ Express Mail No.:

Missing Parts, Formal Papers
- ☐ Response to Notice of Missing Parts
- ☐ Assignment & Cover sheet (_____ pgs.)
- ☐ Declaration & POA (_____ pgs.)

Amendment / Response
- ☐ Amendment/Response After Final (___ pgs.)
- ☐ Terminal Disclaimer
- ☐ Other:_____

Petitions & Appeals
- ☐ Petition for Extension of Time:
- ☐ Notice of Appeal
- ☒ Appeal Brief & two copies (_12_ pgs. each)
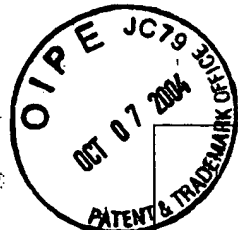- ☐ Reply Brief (_____ pgs.)

Other
- ☐ Information Disclosure Statement & PTO/SB/08 (___ pgs.) (previously 1449)
- ☐ Request to Publish (Rescind NonPublication)
- ☐ Drawings: _____ sheets, _____ figures
- ☒ Postcard

Checks
- ☒ Check No. 67852 Amount $340.00

FEE TRANSMITTAL FOR FY 2005
(FY 2005 Begins 10/01/2004)

TOTAL AMOUNT OF PAYMENT ($)   340.00

Complete if Known:

Application No.	09/737,140
Filing Date	December 13, 2000
First Named Inventor	Andrew J. Fish
Examiner Name	Truong, Lechi
Art Unit	2126
Attorney Docket No.	042390.P9468

_____ Applicant claims small entity status. See 37 CFR 1.27.

METHOD OF PAYMENT (check all that apply)

__X__ Check   _____ Credit Card   _____ Money Order   _____ Other   _____ None

_____ Deposit Account

    Deposit Account Number :   02-2666

    Deposit Account Name:

__X__ The Director is Authorized to do the following with respect to the above-identified Deposit Account:

    _____ Charge fee(s) indicated below.

    __X__ Credit any overpayments.

    __X__ Charge any additional fees during the pendency of this application.

    __X__ Any concurrent or future reply that requires a petition for extension of time should be treated as incorporating an appropriate petition for extension of time and all required fees should be charged.

    _____ Charge fee(s) indicated below **except for the filing fee**.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity		Small Entity			
Fee Code	Fee ($)	Fee Code	Fee ($)	Fee Description	Fee Paid
1001	790	2001	395	Utility application filing fee	_____
1002	350	2002	175	Design application filing fee	_____
1003	550	2003	275	Plant filing fee	_____
1004	790	2004	395	Reissue filing fee	_____
1005	160	2005	80	Provisional application filing fee	_____

SUBTOTAL (1) $ 0.00

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

	Extra Claims		Fee from below	Fee Paid
Total Claims _____	– 20** = _____	X	$18.00	= _____
Independent Claims ____	– 3** = _____	X	$88.00	= _____
Multiple Dependent			_____	= _____

**Or number previously paid, if greater; For Reissues, see below.

Large Entity		Small Entity			
Fee Code	Fee ($)	Fee Code	Fee ($)	Fee Description	
1202	18	2202	9	Claims in excess of 20	
1201	88	2201	44	Independent claims in excess of 3	
1203	300	2203	150	Multiple dependent claim, if not paid	
1204	88	2204	44	**Reissue independent claims over original patent	
1205	18	2205	9	**Reissue claims in excess of 20 and over original patent	

SUBTOTAL (2) $ 0.00

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